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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/385,315
Filing Date: August 30, 1999
Appellant(s): PARROTT, WILLIAM M.

Mark L. Watson, Reg. No. 46,322
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 09 January 2006 appealing from the Office action mailed 13 May 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

234920	Kobayashi	12-97
5,636,264	Sulavuori et al.	6-1997
6,574,266	Haartsen	6-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1, 2, 4-11, 13-17, 21 and 22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi, UK Patent Application 234920 in view of Sulavuori et al. (Sulavuori), U.S. Patent No. 5,636,264 in view of Haartsen, U.S. Patent No. 6,574,266.
3. Regarding **claim 1**, Kobayashi discloses the invention substantially as claimed. Kobayashi discloses *an adapter* (Kobayashi teaches an option apparatus, infrared type connection apparatus, portable phone antenna and base station), [see Kobayashi, page 1, lines 4-7, page 2 line1, apparatus 1, see figure 2a, Figure 5b, page 35, line 23-27 & page 36, line 1], *comprising: an infrared transceiver* (Kobayashi teaches an Infrared Transmitter/Receiver circuit), [see Kobayashi, page 14, lines 12-15] *to transmit and receive information to and from an infrared data port* [see Kobayashi, page 35, lines 23-27]; *a radio frequency transceiver* (Kobayashi teaches Radio Transmitter/Receiver circuit), [see Kobayashi, page 12, lines 15-20] *to transmit and receive information to and from a radio frequency data system* [see Kobayashi, Page 36, lines 1-4]; *and a processor* [Kobayashi teaches a control circuit], [see Kobayashi, page 13, line 5-6, page 15, lines 5-25 and page 35, lines 7-9] *coupled to the infrared transceiver and the radio frequency transceiver* [see Kobayashi, page 9, lines 8-11, page 15, lines 18-25].

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Eventhough, Kobayashi does imply well-known techniques of conversions of signals [see Kobayashi, page 17, lines 17-27, page 18, lines 1-17 and page 20, lines 2-21]. Eventhough, Kobayashi does provide for a control circuit (processor) that converts signals. However, Kobayashi does not explicitly disclose the details of the converting information from the infrared transceiver to a radio frequency format for transfer to the radio frequency data system and to convert information received from the radio frequency transceiver to an infrared format for transfer to the infrared data port.

4. In the same field of endeavor, Sulavuori discloses (e.g., radio telephone which utilizes an infrared signal communication link). Sulavuori discloses *converting information from the infrared transceiver to a radio frequency format for transfer to the radio frequency data system and to convert information received from the radio frequency transceiver to an infrared format for transfer to the infrared data port* [see Sulavuori, Col. 8, lines 47-67, Col. 9, lines 1-28 and Col. 10, lines 5-14].

5. Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Sulavuori's teachings of an radio telephone which utilizes an infrared signal communication link with the teachings of Kobayashi, for the purpose of providing reliable communication between a radio transceiver and an external device, while maintaining a very low power consumption [see Sulavuori, Col. 2, lines 31-60]. However, Kobayashi-Sulavuori does not explicitly disclose a Bluetooth transceiver via Bluetooth interface and Bluetooth protocol.

6. In the same field of endeavor, Haartsen discloses (e.g., a systems that provides for low power consumption and still obtaining fast connection setups). Haartsen discloses Bluetooth

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transceiver, Bluetooth interface and Bluetooth protocol (Haartsen teaches a Bluetooth system that has a transmitting section and a receiving section), [see Haartsen, Col. 4, lines 6-63].

7. Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Haartsen's teachings of a systems that provides for low power consumption and still obtaining fast connection setups with the teachings of Kobayashi-Sulavuori. Kobayashi provides motivation to combine by stating the need to be able to transmit and receive signals via the public network between a Portable device and other apparatuses [see Kobayashi, page 7]. By this rationale **claim 1** is rejected.

8. Regarding **claim 2**, Kobayashi-Sulavuori and Haartsen discloses *comprising a buffer to provide temporary storage for information converted by the processor* (Kobayashi teaches a memory circuit), [see Kobayashi, page 13 line 15]. By this rationale **claim 2** is rejected.

9. Regarding **claim 4**, Kobayashi-Sulavuori and Haartsen discloses *wherein the infrared transceiver includes a driver circuit to transmit information to the infrared data port* [see Kobayashi, page 14, lines 12-15]. By this rationale **claim 4** is rejected.

10. Regarding **claim 5**, Kobayashi-Sulavuori and Haartsen discloses *wherein the infrared transceiver includes a receiving circuit to receive information from the infrared data port* (Kobayashi teaches a transceiver/receiver circuit), [see Kobayashi, page 12, lines 15-20]. By this rationale **claim 5** is rejected.

11. Regarding **claim 6**, Kobayashi-Sulavuori and Haartsen discloses *comprising a housing* (Kobayashi teaches and option apparatus for a portable telephone), [see Kobayashi, page 22, lines 14-16 and Figure 5b]. By this rationale **claim 6** is rejected.

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12. Regarding **claim 7**, Kobayashi-Sulavuori and Haartsen further discloses *a system* [see Kobayashi, Figure 9, portable type computer, see page 35 lines 1-13 base station, portable telephone, and portable computer comprise a network] *comprising: a computing device including an infrared data port* [see Kobayashi, Figure 9, item 31], *the infrared port configured to send and receive information to a radio frequency data system* [see Kobayashi, page 35, lines 13-15)] *the radio frequency data system* [see Kobayashi, page 35, lines 1-3] *in communication with the network and configured to send and receive information* [see Kobayashi, page 35, lines 15-17 and page 36 lines 4-8]; *and an adapter to transfer information between the infrared data port and the radio frequency data system* [see Kobayashi, Figure 9, item 1], *the adapter including: an infrared transceiver to transmit and receive information to and from the infrared data port* [see Kobayashi, page 35, lines 23-27]; *a radio frequency transceiver to transmit and receive information to and from the radio frequency data system* [see Kobayashi, page 36, lines 1-4]; *and a processor* [see Kobayashi, see figure 3, control circuit CPU 120] *coupled to the infrared transceiver and the radio frequency transceiver* [see Kobayashi, figure 9, radio transmitter/receiver 11 and infrared transmitter/receiver 163] *to convert information received from the infrared transceiver to a radio frequency format for transfer to the radio frequency data system and to convert information received from the radio frequency transceiver to an infrared format for transfer to the infrared data port* [see Sulavuori, Col. 8, lines 47-67, Col. 9, lines 1-28 and Col. 10, lines 5-14]. By this rationale **claim 7** is rejected.

13. Regarding **claim 8**, Kobayashi-Sulavuori and Haartsen further discloses *wherein the computing device is a portable computer* [see Kobayashi, Figure 9, portable type computer]. By this rationale **claim 8** is rejected.

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14. Regarding **claim 9**, Kobayashi-Sulavuori and Haartsen further discloses *wherein the adapter physically connects to the computing device* [See Kobayashi, page 2, lines 21-23]. By this rationale **claim 9** is rejected.

15. Regarding **claim 10**, Kobayashi-Sulavuori and Haartsen further discloses *wherein the adapter is a stand-alone unit* [see Kobayashi, semi-fixedly inserted page 22, lines 14-16 and see option apparatus for portable telephone Figure 5b] *that communicates with the computing device* [see Kobayashi, Figure 4, portable telephone comprises control circuit 22 w/CPU 120] *over an infrared communication link* [see Kobayashi, Figure 5b infrared type connection apparatus 29 and 16]. By this rationale **claim 10** is rejected.

16. Regarding **claim 11**, Kobayashi-Sulavuori and Haartsen further discloses *wherein the adapter further comprises a buffer to provide temporary storage for information converted by the processor* [see Kobayashi, memory circuit page 13, line 15]. By this rationale **claim 11** is rejected.

17. Regarding **claim 13**, Kobayashi-Sulavuori and Haartsen further discloses *wherein the infrared transceiver includes a driver circuit to transmit information to the infrared data port* [see Kobayashi, page 14, lines 12-15]. By this rationale **claim 13** is rejected.

18. Regarding **claim 14**, Kobayashi-Sulavuori and Haartsen further discloses *wherein the infrared transceiver includes a receiving circuit to receive information from the infrared data port* [see Kobayashi, page 12, lines 15-20]. By this rationale **claim 14** is rejected.

19. Regarding **claim 15**, the limitations of this claim are substantially the same as that of claims 1 and 7, and thus are rejected for the same rationale in rejecting claims 1 and 7.

Furthermore, with regards to the limitations of a plurality of infrared data ports (It would have

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been obvious to one of ordinary skill in the art at the time the invention was made to use a plurality of computing devices having infrared data ports, a plurality of infrared transceivers, and a processing means in communication with said plurality of infrared transceivers because the optimization of proportions in a prior art device is a design consideration within the skill of the art). In re Reese, 290 F.2d 839, 129 USPQ 402 (CCPA 1961). By this rationale **claim 15** is rejected.

20. Regarding **claim 16**, Kobayashi-Sulavuori and Haartsen further discloses *a method for wirelessly connecting a computing device to a network* [see Kobayashi, Figure 9, portable type computer and page 35 lines 1-13 base station, portable telephone, and portable computer comprise a network], *comprising: receiving information over an infrared communication link from a remote computing device* [see Kobayashi, page 35, lines 18-23]; *converting the information from an infrared format to a radio frequency format at a processor* [see Sulavuori, Col. 8, lines 47-67, Col. 9, lines 1-28 and Col. 10, lines 5-14]; *and communicating the information to the network over a radio frequency link* [see Kobayashi, page 36, lines 4-5]. By this rationale **claim 16** is rejected.

21. Regarding **claim 17**, Kobayashi-Sulavuori and Haartsen further discloses *receiving information over a radio frequency communication link from the network* [see Kobayashi, page 35 lines 1-13 base station, portable telephone, and portable computer comprise a network]; *converting the information from a radio frequency format to a infrared signal at a processor* [see rejection of claim 16, supra]; *and communicating the information to the computing device over an infrared communication link* [see rejection of claim 16, supra]. By this rationale **claim 17** is rejected.

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22. Regarding **claim 21**, Kobayashi-Sulavuori and Haartsen further discloses *wherein the adapter further comprises a buffer to provide temporary information storage* [see Kobayashi, memory circuit page 13 line 15]. By this rationale **claim 21** is rejected.

23. Regarding **claim 22**, the limitations of this claim are substantially the same as that of claim 1, and are thus rejected for the same rationale in rejecting claim 1.

Claim Rejections - 35 USC § 103

24. **Claims 3 and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi-Sulavuori and Haartsen as applied to claims 1, 7, 15, 16, 17 and 22 above, and further in view of well known in the art.

25. Regarding **claim 3**, Kobayashi-Sulavuori discloses the invention substantially as claimed. Kobayashi-Sulavuori does not explicitly teach the adapter further comprising a power supply in communication with the processor. Kobayashi teaches *the adapter (option apparatus) for the telephone is electrically connected to the portable telephone* (page 2, lines 21-23). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Kobayashi to include a power supply because in order for the adapter to be electrically connected a power supply must be present. By this rationale **claim 3** is rejected.

26. Regarding **claim 12**, Kobayashi-Sulavuori and Haartsen and well known in the art teaches the invention as claimed as noted above; However, Kobayashi- Sulavuori does not explicitly teach the adapter further *comprises a power supply coupled to the microprocessor*.

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Kobayashi teaches *the adapter (option apparatus) for the telephone is electrically connected to the portable telephone* (page 2, lines 21-23). By this rationale **claim 12** is rejected.

(10) Response to Argument

The Appellant argued in substance that:

Issue 1), Appellant argues on page 8, that claims 1, 2, 4-6, 15 and 21 were improperly rejected because the combination of Kobayashi, Sulavuori and Haartsen do not disclose or suggest a processor coupled to an infrared transceiver and a Bluetooth transceiver to convert information received from the infrared transceiver to a Bluetooth protocol format for transfer to a data system and to convert information received from the Bluetooth transceiver to an infrared format for transfer to the infrared data port.

As to “Issue 1”, it is the Examiner’s position that the combination of Kobayashi-Sulavuori and Haartsen does in fact to this particular limitation as well as other claimed limitation. Specifically, with regards to Kobayashi teaching the conversion from IR to RF and RF to IR [page 9, lines 8-13]. Kobayashi further teaches a control circuit comprising a processor (CPU) [figure 3, control circuit 12]. This processor of the control circuit is shown to process signals between transceivers [page 13, lines 8-11] and convert signals into IR [page 35, lines 7-9]. Examiner would again like to also direct Applicant’s attention to the portions of their specification (page 6, starting at line 7) that does not explicitly go into the actual details of how this conversion process takes place. The specification states that, “the IR to RF adapter (140) receives the information over an IR communication link, converts the information from an IR format to an RF format compatible with RF data system (130), and transfers the information to

network 120 via RF data system (130).” Also, Applicant further implies that the conversion involves changing the communication protocol from an IR format to a RF format compatible with RF data system (see page 6, lines 25-32. Applicant also states that there is a program to do this conversion. Examiner would like to know where this program is within the specification. With regards to Kobayashi teaches that the radio transmitter/receiver circuit converts the transmission data into a radio signal by the antenna [see Kobayashi, pages 14 and 36]. Applicant also states on page 9, paragraph 1 that Kobayashi does not teach that these conversions are **fully** performed by the control circuit. Thus, by Applicant’s own admission, conversion by the control circuit does take place. Applicant has not specified within the claim limitation nor has the examiner located within the disclosure that the conversion process must be fully performed by the control circuit. Also it is explicitly taught within Kobayashi that the entire system is controlled by the control circuit [see Kobayashi, page 13, lines 5-13]. Thus, inherently within Kobayashi, the controlled circuit is controlling any conversion that takes place. Furthermore, with regards to converting information received from the infrared transceiver to a Bluetooth protocol format. It would have been obvious to one of ordinary skill in the networking art at the time the invention was made for Kobayashi system that allows for infrared and radio frequency conversion to have been utilized for converting signals to a Bluetooth protocol format since Haartsen does disclose the well know teachings of Bluetooth technology.

Issue 2), Appellant argues on page 11, that it would be impermissible hindsight based on Appellant’s own disclosure to incorporate the option apparatus for a portable terminal in Kobayashi and the computer/telecopier device with the infrared connection in Haartsen into the

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system and method for establishing ad hoc communication sessions between remote communication terminals discloses in Haartsen.

As to Issue 2 of applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). It is clear from the Examiner that Kobayashi also teaches on page 7 of the disclosure that the device that is being used is a cellular radiotelephone and that the system of Haartsen also states a multitude of different wireless that can be used [see Haartsen, Col. 13, lines 10-25].

(11) Related Proceeding(s) Appendix


No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

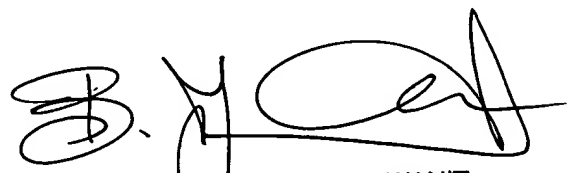
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Lashonda Jacobs

Conferees:


WILLIAM C. VAUGHN, JR.
PRIMARY EXAMINER


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